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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,396	04/26/2001	Stefan Dutzmann	Mo5334/LeA 32,232	4187

34469 7590 03/24/2005

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EXAMINER

CHOI, FRANK I

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/843,396

Applicant(s)

DUTZMANN ET AL.

Examiner

Frank I. Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/402,866.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claim 6 is rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. US Pat. 6,624,183, 6,297,236 and 6,620,822 each disclose the combination of prothioconazole with at least one of the other fungicidal compounds (US 6,620,822, Column 1, lines 30-68, Columns 2,3; US 6,297,236, Column 1, lines 55-68, columns 2-6, column 7, lines 1-30; US 6,624,183, Columns 2-13, Column 14, lines 1-50). However, each of said patents have a different inventive entity than the present invention. As such, it appears that applicant did not invent the claimed subject matter.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The rejection herein is under 102(f) as being expressly disclose not 103(a) as being obvious, as such, 35 USC 103(c) is not applicable herein. The issue under 102(f) is not one of priority or effective dates, as such, submission of a translation of the priority document will not overcome the rejection herein. Applicant is required to provide a 37 CFR 1.132 affidavit providing factual evidence that the inventive entity in the present Applicant did not derive the claimed invention from the inventive entities in the above references, i.e. that the subject matter disclosed in the above references is derived from present inventive entities own work and not the invention of the inventive entity in the above references.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art in view of US Pat. 3,903,090.

Applicant acknowledges that prothioconazole has good fungicidal activity but at low application rates it is in some cases not satisfactory (Specification, Pg. 1). Applicant acknowledges that a large number of triazole derivatives, aniline derivative, dicarboimides and other heterocycles can be employed for controlling fungi, such as set forth in EP A 0 040 345, DE A 2 201 063, DE -A 2 324 0 10, Pesticide Manual, 9<sup>th</sup> ed (1991), pages 249 and 827, U S Pat. No. 3, 903, 090 and EP - A 0 206 999, and that likewise these compounds are not always satisfactory at low application rates (Specification Pg. 1).

US Pat. 3,903,090 discloses that the N-(3,5-dihalophenyl)-imide compounds can be extended with suitable carriers and can be combined with other fungicides (Column 32, lines 20-39).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the combination of prothioconazole with the other fungicides. However, the prior art amply suggests the same as it is known that that the compounds used singly are effective fungicides, and that fungicides can be combined together and be formulated with suitable extenders. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to combine prothioconazole with one or more of the other

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fungicides with the expectation that the combination would be an effective fungicide and that that the formulations could be extended with suitable carriers.

“It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” In re Kerkhoven, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be prima facie obvious.). See also In re Crockett, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote the formation of a nodular structure in cast iron.); and Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held prima facie obvious).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

In the first instance, the rejection is not over a single reference. The acknowledged prior art constitutes at least one reference. As such, the rejection is over a combination of references and Applicant's request for an affidavit is misplaced. Examiner appreciates Applicant's recitation of caselaw, however, Applicant fails to address the acknowledged prior art which is part of the rejection herein. It is the combination of the acknowledged prior art and US Pat. 3,903,090 upon which the rejection is based. This combination discloses that the claimed compounds are fungicides and that fungicides can be combined. Further, as indicated above, it is prima facie obvious to combine two known compounds having the purpose to form a third

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composition having said purpose. The motivation to combine the references or prior art does not have to come from the references or prior art themselves. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. See MPEP 2144. In this case, the rationale comes from the above legal precedent.

With respect to synergy, any evidence of synergism must be commensurate in scope with the claims. Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In re Clemens, 206 USPQ 289, 296 (CCPA 1980) (Claims were directed to a process for removing corrosion at “elevated temperatures” using a certain ion exchange resin (with the exception of claim 8 which recited a temperature in excess of 100C). Appellant demonstrated unexpected results via comparative tests with the prior art ion exchange resin at 110C and 130C. The court affirmed the rejection of claims 1-7 and 9-10 because the term “elevated temperatures” encompassed temperatures as low as 60C where the prior art ion exchange resin was known to perform well. The rejection of claim 8, directed to a temperature in excess of 100C, was reversed.). See also In re Peterson, 65 USPQ2d 1379, 1382-5 (Fed. Cir. 2003) (data showing improved alloy strength with the addition of 2% rhenium did not evidence unexpected results for the entire claimed range of about 1-3% rhenium); In re Grasselli, 218 USPQ 769, 777 (Fed. Cir. 1983) (Claims were directed to certain catalysts containing an alkali metal. Evidence presented to rebut an obviousness rejection compared catalysts containing sodium with the prior art. The

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court held this evidence insufficient to rebut the prima facie case because experiments limited to sodium were not commensurate in scope with the claims.). The examples in Applicant's Specification use specified amounts and treat specified pathogens. Applicant has made no showing that the purported evidence of synergy is commensurate in scope with the claims which do not indicate amounts, other than a broad ratio in claim 7, and include within their scope any fungal pathogen.

With respect to Applicant citation to US Pat. 6,306,850, the fact that synergy may have been recognized in US Pat. 6,306,850 by a different examiner involving claimed subject matter which is different from the subject matter claimed in the present Application has no bearing on the prosecution of the present Application. See e.g. *In re Ruschig*, 154 USPQ 118, 120, 121 (CCPA 1967) (the doctrines of estoppel, res judicata, laches, etc., i.e., the fact that the Patent Office may have decided one way on an issue previously, do not preclude the Patent Office from reviewing a previous decision and arriving at a different conclusion on the same issue).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being obvious over WO 96/16048.

WO 96/16048 discloses the combination of prothioconazole with other fungicides, including propineb, dimethomorph and fosetyl-aluminum, to widen the spectrum of action, to prevent build of resistance and that the activity of the mixture in many cases exhibits synergistic activity and that the formulations are prepared in a known manner, for example by mixing the active compounds with surfactants and extenders, and that application concentrations of the

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active compounds depend on the nature and occurrence of the microorganisms to be controlled and on the composition of the material to be protected and the optimum amount to be employed can be determined by a series of tests(see entire reference, especially, Pg. 42, lines 11-15, Pg. 43, lines 15-30, Pg. 44, Pg. 47).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the combination of prothioconazole with the other fungicides. However, the acknowledged prior art amply suggests the same as it is known that that the compounds used singly are effective fungicides, that prothioconazole can be combined with other fungicides and that they can be formulated with surfactants and extenders. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to combine prothioconazole with one or more of the other fungicides with the expectation that the combination would be more effective than each alone and that surfactants and extenders would be suitable for use in the formulation.

“It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” In re Kerkhoven, 850, 205 USPQ 1069, 1072 (CCPA 1980) (citations omitted) (Claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dried detergents were held to be prima facie obvious.). See also In re Crockett, 126 USPQ 186 (CCPA 1960) (Claims directed to a method and material for treating cast iron using a mixture comprising calcium carbide and magnesium oxide were held unpatentable over prior art disclosures that the aforementioned components individually promote



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the formation of a nodular structure in cast iron.); and Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) (mixture of two known herbicides held *prima facie* obvious).

Examiner has duly considered Applicant's arguments but deems them unpersuasive for the same reasons as above. Examiner acknowledges Applicant's indication of a typographical error in the prior Office Action – WO 96/126048 cited in the prior Office Action should have been WO 96/16048 as indicated above.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Examiner acknowledges Applicant's request that Examiner contact Applicant by telephone regarding the translation prior to mailing out an Office Action. However, said request is respectfully declined as Applicant's arguments have not overcome the rejections herein and filing a translation will not overcome all of the rejections herein except for the rejection over WO 96/16048.

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIC

March 20, 2005



SABIHA QAZI, PH.D  
PRIMARY EXAMINER